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REEXAM UNIT

In re Application of
Chris Buhr *et al*
Application No. 09/408,396
Filed: September 29, 1999
Atty. Docket No.: 8GSLIS-0128

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: ORDER TO
: SHOW CAUSE
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This is a show cause order based on the expiration of U.S. patent, while the present application requests reissue of that patent.

BACKGROUND

1. The present application was filed September 29, 1999, for reissue of U.S. patent 5,672,697 (the '697 patent) issued September 30, 1997.
2. On March 23, 2006, the examiner completed examination of the present application ("present reissue proceeding") and prepared a Notice of Allowability for mailing that indicated that claims 1-26 (all of the claims) were allowable. The examiner's Notice of Allowance, and a Notice of Allowability, were mailed together on that date.
3. On April 20, 2006, the Technology Center Director withdrew the present application from issue. The issue fee had not been paid.
4. The Office's financial records reveal that the 3.5 year maintenance fee due by September 30, 2001 (the end of the grace period), was not paid by October 1, 2001 (a Monday).
5. The '697 patent has expired for failure to pay the 3.5 year maintenance fee. See 1253 *Official Gazette*, Vol. 1 (December 4, 2001).
6. The Office financial records do not reveal a payment of the 7.5 year maintenance fee, which would have been due by September 30, 2005 (the end of the grace period), had the '697 patent been subsequently revived.

ORDER TO SHOW CAUSE

As pointed out above, the present reissue proceeding is for reissue of the '697 patent, and that patent expired for failure to pay the 3.5 year maintenance fee by September 30, 2001. On December 4, 2001, a Notice of the expiration of the '697 patent was published in the *Official Gazette*. Since the '697 patent has expired for failure to pay the first maintenance fee, the Director of the USPTO no longer has the authority under 35 U.S.C. § 251 to reissue the '697 patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993).

As stated in *Morgan*,

"The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only "for the unexpired part of the term of the original patent." Thus, when *Morgan's original patent expired* on August 19, 1992, the Commissioner was divested of his reissue authority because there no longer was an unexpired term of the patent for which *Morgan's patent could be reissued*. *Morgan's appeal thus became moot*." [990 F.2d at 1231, 26 USPQ2d at 1393; Emphasis added]

Because the Director no longer has the authority under 35 U.S.C. § 251 to reissue the patent, the Office intends to terminate the present reissue proceeding, and thereafter hold the application for reissue of the '697 patent to be an abandoned application.

It is to be observed that, even if the '697 patent had been subsequently reinstated by acceptance of a delayed 3.5 year maintenance fee, the 7.5 year maintenance fee has not been shown to have been paid. Thus, the patent would be expired for failure to pay the 7.5 year maintenance fee.

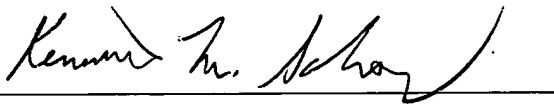
Applicant is hereby being provided with a period of 30 DAYS from the mailing of this ORDER to show cause why the Office should not terminate the present reissue proceeding.

If applicant proposes to show cause why the present reissue proceeding should not be terminated, applicant's showing must include an explanation of why the proceeding should continue in spite of the expiration of the original patent.

If applicant makes a showing, the showing will be evaluated as to whether it provides sufficient basis why the present reissue proceeding should not be terminated. A failure to present any reasons for not vacating these proceedings within the 30 day period will result in the proceedings being terminated by default. If the present reissue proceeding is terminated, the application for reissue of the '697 patent will be returned to Technology Center 1600 for processing as an abandoned application.

CONCLUSION

1. Applicant is being provided with a period of 30 DAYS from the mailing of this ORDER to show cause why the Office should not terminate the present reissue proceeding.
2. Failure by applicant to respond to this show cause order within the 30 day period will result in termination of the proceeding by default, followed by a mailing of a Notice of Abandonment in the application for reissue of the '697 patent.
3. The paper file for reissue application 09/408,396 is being stored in the Office of Patent Legal Administration, pending a response by applicant, or the expiration of time for a response.
4. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743 or, in his absence to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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May 8, 2006

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